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Kenichi Asada

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4980

7590

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Steven I Weisburd

Dickstein Shapiro Morin & Oshinsky LLP

1177 Avenue of the Americas 41st Floor

New York, NY 10036-2714

EXAMINER

RAMOS FELICIANO, ELISEO

ART UNIT

PAPER NUMBER

2687

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/006,577

Applicant(s)

ASADA, KENICHI

Examiner

Eliseo Ramos-Feliciano

Art Unit

2687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10, and 12 is/are rejected.
- 7) ☒ Claim(s) 5, 11 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claim Objections*

2. **Claim 3** is objected to because of the following informalities: it recites the limitation "at least one base station" in line 7, "a base station" in line 9; and "said base station" in line 11. It is not clear if all of the recited base stations are the same base station. For examination on the merits all of them will be treated as being the same. Correction is required.
3. **Claim 7** is objected to because of the following informalities: the claim has been written in narrative form; should be in active form. For example, --confirming-- and --allowing-- instead of "confirms" and "allows". The language of the claim, as presently redacted, may lead to confusion because one may understand that the confirmation step is performed "after said step (a)", when it should be that the confirmation step is performed first, then "step (a)" is performed. Appropriate correction is required.
4. **Claim 10** is objected to because of the following informalities: it recites the limitation "said power source" in line 13. Should be --said main power source--. Correction is required.
5. **Claim 11** is objected to because of the following informalities: it recites the limitation "said power source" in line 13. Should be --said main power source--. Correction is required.
6. **Claim 13** is objected to because of the following informalities: it recites the limitation "at least one base station" in line 14, "a base station" in line 16; and "said base station" in line 23.

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It is not clear if all of the recited base stations are the same base station. For examination on the merits all of them will be treated as being the same. Correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 8 and 10** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. **Claim 8** recites the limitation "The method according to claim 5" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim; since claim 5 is a system claim; not a method claim. It appears that the cited limitation should read --The method according to claim 6-- instead. For examination on the merits the claim will be treated as if dependent on claim 6.

10. **Claim 10** recites the limitation "said location information detecting section" in line 11. There is insufficient antecedent basis for this limitation in the claim. For examination on the merits the limitation will be treated as --said main power source ON information detecting section-- instead.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. **Claims 1-4, 6, 8-10, and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda (US Patent Number 6,169,905) in view of Gillig et al. (US Patent Number 4,989,230).

Regarding **claim 1**, Fukuda discloses a notification system (Figure 4) for communicating (telephone call) between a sender phone (for example, remote station 4) and a receiver phone (for example, remote station 8) (telephone call between remote stations – column 5, line 28; and column 6, line 56) including:

a system configuration (Figures 4-5) for allowing said sender phone to transmit an ON state indication signal (control signal – Figure 5) indicating to switch ON a main power source (power supply) of said receiver phone through a radio wave (column 5, line 29) to said receiver phone being in an OFF state (the remote station turns ON a power supply of its reception unit on the basis of a control signal – abstract, last three lines),

such that said main power source of said receiver phone is remotely turned ON (column 3, lines 58-60; column 4, lines 11-13; see column 6, lines 42-59).

However, even though Fukuda teaches that the remote station (sender phone or receiver phone) can be a digital cordless telephone (column 5, lines 5-7), Fukuda fails to specifically mention that the remote station is a cellular phone as claimed.

In the same field of endeavor, Gillig et al. discloses a notification system (Figure 1) that includes a cellular cordless telephone that may place/receive both cellular telephone calls and cordless telephone calls (column 1, lines 31-35; column 7, lines 64-68). In other words, Gillig et al. teaches a phone that can operate both cellular and cordless technology.

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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Fukuda's digital cordless telephones (remote stations: sender phone and receiver phone) to also be cellular telephones because this would enable to place or receive both cellular telephone calls and cordless telephone calls, as taught by Gillig et al., having the further advantage of expanded service area coverage.

Regarding **claim 2**, Fukuda and Gillig et al. disclose everything claimed as applied above (see *claim 1*). In addition, Fukuda discloses that after said receiver cellular phone becomes in said ON state, said receiver cellular phone is notified that a call is received (analog audio signal; the user can answer the incoming call – column 7, lines 1-25).

Regarding **claim 3**, Fukuda discloses a notification system (Figure 4) for communicating (telephone call) between a sender phone (for example, remote station 4) and a receiver phone (for example, remote station 8) (telephone call between remote stations – column 6, line 56) including:

a base station controlling device ("main master station 1" – column 5, line 55) for receiving receiver information (connection request control signal – column 1, line 30; column 6, line 45-47) "concerning" said receiver phone which main power source is in an OFF state (power supply of reception unit OFF), and for controlling at least one base station ("sub master stations 2 and 3" – column 5, lines 56-57) covering an area (inherent) indicated in said receiver information (column 5, lines 53-63); and

a base station ("sub master stations 2 and 3" – column 5, lines 56-57) for sending said receiver information, wherein:

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said base station comprises a sub-system configuration for sending power-ON information (control signal – Figure 5) based on said receiver information received from said base station controlling device; and

said receiver phone comprises a device configuration for receiving said power-ON information from said base station even if said main power source is in said OFF state (the remote station turns ON a power supply of its reception unit on the basis of a control signal – abstract, last three lines) (see column 3, lines 58-60; column 4, lines 11-13; column 6, lines 42-59).

However, even though Fukuda teaches that the remote station (sender phone or receiver phone) can be a digital cordless telephone (column 5, lines 5-7), Fukuda fails to specifically mention that the remote station is a cellular phone as claimed.

In the same field of endeavor, Gillig et al. discloses a notification system (Figure 1) that includes a cellular cordless telephone that may place/receive both cellular telephone calls and cordless telephone calls (column 1, lines 31-35; column 7, lines 64-68). In other words, Gillig et al. teaches a phone that can operate both cellular and cordless technology.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Fukuda's digital cordless telephones (remote stations: sender phone and receiver phone) to also be cellular telephones because this would enable to place or receive both cellular telephone calls and cordless telephone calls, as taught by Gillig et al., having the further advantage of expanded service area coverage.

Regarding **claim 4**, Fukuda and Gillig et al. disclose everything claimed as applied above (see *claim 3*). In addition, Fukuda discloses that the receiver information includes at least one of

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a receiver cellular phone telephone number, a password to access said receiver cellular prone, and area information indicating an area where said receiver cellular phone is predicted to be. For example, identification No. of the target remote station (receiver cellular phone telephone number) (column 2, line 9).

Regarding **claim 6**, Fukuda discloses a method for communicating (telephone call) between a sender phone (for example, remote station 4) and a receiver phone (for example, remote station 8) (telephone call between remote stations – column 5, line 28; and column 6, line 56) including:

allowing said sender phone to transmit an ON state indication signal (control signal – Figure 5) indicating to switch ON a main power source (power supply) of said receiver phone through a radio wave (column 5, line 29) to said receiver phone being in an OFF state (the remote station turns ON a power supply of its reception unit on the basis of a control signal – abstract, last three lines),

such that said main power source of said receiver phone is remotely turned ON (column 3, lines 58-60; column 4, lines 11-13; see column 6, lines 42-59).

However, even though Fukuda teaches that the remote station (sender phone or receiver phone) can be a digital cordless telephone (column 5, lines 5-7), Fukuda fails to specifically mention that the remote station is a cellular phone as claimed.

In the same field of endeavor, Gillig et al. discloses a notification system (Figure 1) that includes a cellular cordless telephone that may place/receive both cellular telephone calls and cordless telephone calls (column 1, lines 31-35; column 7, lines 64-68). In other words, Gillig et al. teaches a phone that can operate both cellular and cordless technology.



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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Fukuda's digital cordless telephones (remote stations: sender phone and receiver phone) to also be cellular telephones because this would enable to place or receive both cellular telephone calls and cordless telephone calls, as taught by Gillig et al., having the further advantage of expanded service area coverage.

Regarding **claim 8**, Fukuda and Gillig et al. disclose everything claimed as applied above (see *claim 6*). In addition, Fukuda discloses that after said receiver cellular phone becomes in said ON state, said receiver cellular phone is notified that a call is received (analog audio signal; the user can answer the incoming call – column 7, lines 1-25).

Regarding **claim 9**, Fukuda discloses a phone (remote station 4 – Figure 4) comprising a device configuration for receiving a signal (control signal – Figure 5) for switching to be in an ON state from a base station (master station – Figure 4; column 5, lines 53-63) and being capable of switching a main power source to be in said ON state even if said main power source is in an OFF state (the remote station turns ON a power supply of its reception unit on the basis of a control signal – abstract, last three lines; column 3, lines 58-60; column 4, lines 11-13; see also column 6, lines 42-59).

However, even though Fukuda teaches that the remote station (phone) can be a digital cordless telephone (column 5, lines 5-7), Fukuda fails to specifically mention that the remote station is a cellular phone as claimed.

In the same field of endeavor, Gillig et al. discloses a notification system (Figure 1) that includes a cellular cordless telephone that may place/receive both cellular telephone calls and

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cordless telephone calls (column 1, lines 31-35; column 7, lines 64-68). In other words, Gillig et al. teaches a phone that can operate both cellular and cordless technology.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Fukuda's digital cordless telephones (remote stations: sender phone and receiver phone) to also be cellular telephones because this would enable to place or receive both cellular telephone calls and cordless telephone calls, as taught by Gillig et al., having the further advantage of expanded service area coverage.

Regarding **claim 10**, Fukuda and Gillig et al. disclose everything claimed as applied above (see *claim 9*). In addition, Fukuda further discloses:

1) Establishing synchronization with at least said base station (via "sync word" in control signal – column 5, line 40) even if said main power source is in said OFF state (the remote station receives the control signal even when in standby mode which is an OFF state because the power supply of its reception unit is OFF – column 6, lines 25-30; column 2, lines 10-12).

Therefore, a synchronization establishing circuit as claimed is inherent.

2) Extracting main power source ON information from a radio wave (column 5, line 29) transmitted from said base station (the remote station turns ON a power supply of its reception unit on the basis of a control signal – abstract, last three lines; column 3, lines 58-60; column 4, lines 11-13; see column 6, lines 42-59). Therefore, a main power source ON information detecting section as claimed is inherent.

3) A power source section (these limitations are inherent from above because the claimed circuit inherently needs power to operate) for supplying electric power to said main power source ON information detecting section and said main power source ON information detecting section

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to be kept in an ON-state, even if said main power source is in said OFF state, and for turning ON said main power source when said main power source ON information is input from said main power source ON information detecting section (abstract; column 3, lines 58-60; column 4, lines 11-13; and column 6, lines 42-59).

Regarding **claim 12**, Fukuda and Gillig et al. disclose everything claimed as applied above (see *claim 9*). As explained above Fukuda and Gillig et al. disclose the claimed cellular phone. The cellular phone “is used” as a receiver cellular phone in a notification system for communicating between a sender cellular phone and said receiver cellular phone. In addition, Fukuda further discloses wherein said notification system comprises:

a system configuration (Figures 4-5) for allowing said sender phone to transmit an ON state indication signal (control signal – Figure 5) indicating to switch ON a main power source (power supply) of said receiver phone through a radio wave (column 5, line 29) to said receiver phone being in an OFF state (the remote station turns ON a power supply of its reception unit on the basis of a control signal – abstract, last three lines),

such that said main power source of said receiver phone is remotely turned ON (column 3, lines 58-60; column 4, lines 11-13; see column 6, lines 42-59).

13. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda in view of Gillig et al. as applied to *claim 6* above, and further in view of MPEP 2144.03. Tsuchiyama (US Patent Number 5,847,657).

Regarding **claim 7**, Fukuda and Gillig et al. disclose everything claimed as applied above (see *claim 6*). However, they fail to specifically disclose confirming that the main power source

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of the receiver cellular phone to be notified is in the OFF state before performing "step (a)" (i.e., remotely turning ON).

The examiner contends that such confirmation step is well known in the art and takes Official notice of such notion, because it is unnecessary to send a switch ON signal if the intended recipient is already ON. It is always desirable to remotely turn ON electronic devices that currently are in OFF state, not ON.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Fukuda and Gillig et al.'s invention to confirm that the receiver cellular phone is in the OFF state before remotely turning it ON, because it is unnecessary to transmit a switch ON signal if the intended recipient is already ON.

***Allowable Subject Matter***

14. **Claims 5, 11 and 13** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The following is a statement of reasons for the indication of allowable subject matter:

**Claim 5** would be allowable because the prior art of record fails to anticipate or render obvious a location information system for sending the claimed receiver information by incorporating into a Global Positioning Satellite signal the signal for switching the receiver cellular phone to be in the claimed ON state, in combination with all other limitations in the claim, the base claim and any intervening claims, as defined by applicant. **Claims 11 and 13** would be allowable for the same reasons just explained.

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*Citation of Pertinent Prior Art*

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Owens et al.** (US Patent Application Publication Number 2004/0180668) discloses an auxiliary activated GPS-equipped wireless phone.

*Conclusion*

17. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 703-305-0078. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid, can be reached on (703) 306-3016. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ERF/erf  
December 21, 2004

  
**ELISEO RAMOS-FELICIANO** 12/21/04  
**PATENT EXAMINER**